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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,498	03/29/2004	Gerald Duhamel	14296-28US CMB/clb	8902
31831 7590 01/17/2007 LABTRONIX CONCEPT INC. C/O OGILVY RENAULT 1981 MC GILL COLLEGE AVENUE SUITE 1600 MONTREAL, QUEBEC, H3A 2Y3 CANADA			EXAMINER LEE, BENJAMIN WILLIAM	
			ART UNIT 3709	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/811,498

Applicant(s)

DUHAMEL ET AL.

Examiner

Benjamin W. Lee

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3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10-6-2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 20 is objected to because of the following informalities: "symbol" in line 5 should be changed to --symbols--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17, 19, and 20 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Re claim 1: The claim is directed toward a method of operating a game. The invention disclosed in the claim is a process, which is one of the four statutory categories of invention (e.g. process, machine, manufacture, and composition of matter). However, the process disclosed in the claim includes the judicial exception of an abstract idea ("operating a game"). No physical transformation is present to establish a practical application of the abstract idea. Furthermore, the process disclosed in the claim does not provide a useful, concrete, and tangible result. "Operating a meter" is useful and concrete, but is not tangible. Therefore, the claim is directed toward non-statutory subject matter.

Re claims 2-17: The claims are dependent on claim 1 and thus inherit the same deficiencies. No further method steps that provide a useful, concrete, and tangible result are disclosed. Therefore, the claims are directed toward non-statutory subject matter.

Re claim 19: The claim is directed toward a computer program. A computer program per se is nonstatutory subject matter. The computer program is embodied on a computer readable medium, which may form manufacture. However, ¶ [042] of the specification states that the invention may be “embodied in a system a computer readable medium or an electrical or electromagnetic signal.” A computer program held on a electromagnetic signal does not fall within the four statutory categories of patentable subject matter set forth in 35 U.S.C. 101. See pages 50-57 of the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” which may be found at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

Re claim 20: The claim is directed toward a computer program carried on an electrical or electromagnetic carrier signal. A computer program held on a electromagnetic signal does not fall within the four statutory categories of patentable subject matter set forth in 35 U.S.C. 101. See pages 50-57 of the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” which may be found at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 8, 9, 15, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Englman (US 2004/0157978 A1).

Re claim 1: Englman discloses a method of operating a game comprising the steps of displaying a line game/slot game (see Fig. 1; ¶ [0024], lines 5-6) and operating a meter displayed as different statuses of an evolving symbol (see Figs. 8-10; ¶ [0039]; ¶ [0040]) wherein at least one of the statuses is used in the line game to trigger a feature. The PLANT symbol 77 enhances (e.g. doubles) a winning combination (see ¶ [0040]).

Re claim 2: The teachings of Englman as applied to claim 1 have been discussed above. Englman further discloses the meter is used to gather occurrences of a predetermined combination of symbols (see ¶ [0039]).

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Re claim 3: The teachings of Englman as applied to claim 2 have been discussed above. Englman further discloses the event dependent of the game outcome is a winning outcome (see ¶ [0039]).

Re claim 5: The teachings of Englman as applied to claim 1 have been discussed above. Englman further discloses the evolving symbol occurs on a reel (see Figs. 8-10; ¶ [0040]), each occurrence of the evolving symbol comprising an Evolving Symbol Unit (ESU).

Re claim 8: The teachings of Englman as applied to claim 5 have been discussed above. Englman further discloses only a portion of the ESUs evolve upon occurrence of an evolution trigger (see Figs. 8-10; ¶ [0040]).

Re claim 9: The teachings of Englman as applied to claim 8 have been discussed above. Englman further discloses the evolution trigger occurs when the meter reaches a predetermined threshold (see ¶ [0039]; ¶ [0040]).

Re claim 15: The teachings of Englman as applied to claim 1 have been discussed above. Englman further discloses the feature triggered in the game by the evolving symbol is a change is a bonus payout. The enhanced PLANT symbol is used to a multiplier for a winning combination along the same pay line (see ¶ [0040]).

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Re claim 17: The teachings of Englman as applied to claim 15 have been discussed above. Englman further discloses the evolving symbol occurs on a reel (see Figs. 8-10; ¶ [0040]), each occurrence of the evolving symbol comprising an Evolving Symbol Unit (ESU) and wherein at least one of the ESUs evolve upon occurrence of an evolution trigger (see Figs. 8-10; ¶ [0040]).

Re claim 18: Englman discloses a meter/system memory 22 for gathering occurrences of a predetermined event (see ¶ [0027]), a game apparatus comprising a display controller for displaying the meter as different statuses of an evolving symbol, according at least in part to a value of the meter (see Figs. 1 and 2; ¶ [0026]), an evaluation means for triggering a feature in a line game (see ¶ [0027]; ¶ [0039]), wherein at least one of the statuses is used in the line game to trigger the feature (see ¶ [0039]).

Re claims 19 and 20: Englman discloses a computer program embodied on a computer readable storage medium or electrical or electromagnetic carrier signal having codes/software (see Fig. 2; ¶ [0026]; ¶ [0027]) adapted to gather occurrences of a predetermined event in a meter (see ¶ [0039]) and display the meter as different statuses of an evolving symbol (see Figs. 8-10; ¶ [0039]; ¶ [0040]), wherein at least of the evolving symbols is used in a line game to trigger a feature (see ¶ [0039]).

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman.

Re claim 4: The teachings of Englman as applied to claim 2 have been discussed above.

However, Englman fails to disclose or fairly suggest the event independent of the game outcome is at least one of a spin, an elapsed length of time, and a bet value.

It is well known in the art to have a bet value meter, which keeps track of a player's bet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bet meter to display as different statuses of an evolving symbol in order provide an entertaining way of informing a player of his/her bet.



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Re claim 16: The teachings of Englman as applied to claim 15 have been discussed above. Englman further discloses the meter is used to gather occurrences of an event dependent of the game outcome wherein the event dependent on the game outcome comprises a predetermined combination of symbols (see ¶ [0039]).

However, Englman fails to disclose or fairly suggest the event independent of the game outcome is at least one of a spin, an elapsed length of time, and a bet value.

It is well known in the art to have a bet value meter, which keeps track of a player's bet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bet meter to display as different statuses of an evolving symbol in order provide an entertaining way of informing a player of his/her bet.

8. Claims 6, 7, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Englman in view of Kaminkow (US 6,780,109 B2).

Re claim 6: The teachings of Englman as applied to claim 5 have been discussed above.

However, Englman fails to disclose or fairly suggest all ESUs evolve upon occurrence of an evolution trigger.

Kaminkow teaches a gaming device featuring transformable wild symbols. All the transformable wild symbols may be activated upon the occurrence of a trigger (see col. 8, lines 15-22).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to evolve the ESUs

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upon the occurrence of an evolution trigger in order to increase a player's chance of winning and thus increase the player's interest in the game.

Re claim 7: The teachings of Englman as modified by Kaminkow as applied to claim 6 have been discussed above. Englman further discloses the evolution trigger occurs when the meter reaches a predetermined threshold (see ¶ [0039]; ¶ [0040]).

Re claim 10: The teachings of Englman as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the number of evolving ESUs is randomly selected.

Kaminkow teaches the number of transformable wild symbols that change states is randomly selected (see col. 10, lines 17-28).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to evolve a random number of ESUs in order to provide another source of unpredictability and chance to the game and thus increase a player's interest in the game.

Re claim 11: The teachings of Englman as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the evolving ESUs are randomly selected.

Kaminkow teaches the transformable wild symbols are randomly selected for changing states (see col. 9, line 66 - col. 10, line 9).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to randomly select ESUs for evolution in order to provide another source of unpredictability and chance to the game and thus increase a player's interest in the game.

Re claim 12: The teachings of Englman as applied to claim 8 have been discussed above.

However, Englman fails to disclose or fairly suggest the evolving ESUs are those displayed when the evolution trigger occurs.

Kaminkow teaches an activator symbol that may activate displayed transformable wild symbols (see col. 10, lines 17-28).

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to evolve displayed ESUs when the evolution trigger occurs in order to prevent the probability of a player winning the game from growing to large.

Re claim 13: The teachings of Englman as applied to claim 5 have been discussed above.

However, Englman fails to disclose or fairly suggest the evolving ESUs evolve at the same rate.

Kaminkow teaches that all the transformable wild symbols may simultaneously change state (see col. 8, lines 15-22). Since there are only two states, the wild symbols change at the same rate.

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Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to have all the ESUs evolve at the same rate in order to increase a player's chances of winning and thus increase the player's interest in the game.

Re claim 14: The teachings of Englman as applied to claim 5 have been discussed above.

However, Englman fails to disclose or fairly suggest each evolving ESU evolves independently.

Kaminkow teaches the transformable wild symbols are randomly selected for changing states (see col. 9, line 66 - col. 10, line 9). Each random determination of the transformable wild symbol is carried out independently.

Therefore, in view of Kaminkow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the game of Englman to have all the ESUs evolve independently in order to increase the complexity of game and make the game more interesting to the player.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kodachi et al. and Inamura disclose gaming machines with changing symbols.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346.

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The examiner can normally be reached on Mon - Thurs (7:30AM-5PM), or Alt. Fri (7:30AM-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/bwl  
Benjamin W. Lee  
January 5, 2007

  
**KIM NGUYEN**  
**PRIMARY EXAMINER**